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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,625	09/27/2001	Yar-Ming Wang	GP-301034	9716

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EXAMINER	
WONG, EDNA	
ART UNIT	PAPER NUMBER
1753	

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/963,625	Applicant(s) WANG ET AL.	
	Examiner Edna Wong	Art Unit 1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 June 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

This is in response to the Amendment dated June 16, 2003. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claim Rejections - 35 USC § 103

I. Claims **1 and 2** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Korte** (US Patent No. 6,309,427) in combination with **Gillich** (US Patent No. 5,760,981).

With respect to claim **2**, the rejection under 35 U.S.C. 103(a) as being unpatentable over Korte in combination with Gillich has been withdrawn in view of Applicants' amendment. Claim 2 has been canceled.

With respect to claim **1**, the rejection under 35 U.S.C. 103(a) as being unpatentable over Korte in combination with Gillich is as applied in the Office Action dated March 14, 2003 and incorporated herein. The rejection has been maintained for the following reasons below.

III. Claim **5** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Korte** (US Patent No. 6,309,427) in combination with **Gillich** (US Patent No. 5,760,981).

The rejection of claim 5 under 35 U.S.C. 103(a) as being unpatentable over Korte in combination with Gillich is as applied in the Office Action dated March 14, 2003 and

incorporated herein. The rejection has been maintained for the following reasons below.

Applicants state that the Korte teaching would not direct anyone, faced with preparing high magnesium content aluminum alloys for coloring, to the solution found by the Applicant. In response, the solution found by the Applicants is an aqueous sulfuric acid bath containing 100 to 200 grams of sulfuric acid per liter of bath. The Examiner maintains that sulfuric acid is commonly used in anodizing baths and that 100 to 200 grams of sulfuric acid per liter of bath is well within the skill of the artisan.

Applicants state that none of the Gillich, Askin et al. and the Komatsubara et al. references recognize the problem of producing a colorable anodized coating on a high magnesium content aluminum alloy. Nor do they teach a solution for it. In response, the rejection is not overcome by pointing out that one reference does not contain a particular limitation when reliance for that teaching is on another reference. *In re Lyons* 150 USPQ 741 (CCPA 1966). Moreover, it is well settled that one cannot show nonobviousness by attacking the references individually where, as here, the rejection is based on a combination of references. *In re Keller* 208 USPQ 871 (CCPA 1981); *In re Young* 159 USPQ 725 (CCPA 1968).

As to a solution to the problem, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to

achieve the same advantage or result discovered by the Applicants. *In re Linter* 458 F 2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon* 919 F 2d 688, 16 USPQ 2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 USPQ 904 (1991); and MPEP § 2144.

Applicants state that there is no logical technical basis to extract the specific processes of claims 1 and 5 from Korte or Gillich when neither reference even contemplates the problem that is solved by the rejected claims. In response, the contemplated problem does not distinguish the method steps from the prior art. Korte teaches a method for coloring aluminum oxide layers, Gillich and Askin teaches conventional pretreatment methods for aluminum alloy substrates, and Komatsubara teaches a reasons for limiting the content of alloying magnesium. To employ the combination for their known functions and to optimize the additives in a method, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

II. Claims **3 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Korte** (US Patent No. 6,309,427) in combination with **Gillich** (US Patent No. 5,760,981)

as applied to claims 1 and 2 above, and further in view of **Askin et al.** (US Patent No. 5,616,231) and **Komatsubara et al.** (US Patent No. 5,181,969).

The rejection of claims 3 and 4 under 35 U.S.C. 103(a) as being unpatentable over Korte in combination with Gillich as applied to claims 1 and 2 above, and further in view of Askin et al. and Komatsubara et al. is as applied in the Office Action dated March 14, 2003 and incorporated herein. The rejection has been maintained for the following reasons below.

IV. Claims **6 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Korte** (US Patent No. 6,309,427) in combination with **Gillich** (US Patent No. 5,760,981) as applied to claim 5 above, and further in view of **Askin et al.** (US Patent No. 5,616,231) and **Komatsubara et al.** (US Patent No. 5,181,969).

The rejection of claims 6 and 7 under 35 U.S.C. 103(a) as being unpatentable over Korte in combination with Gillich as applied to claim 5 above, and further in view of Askin et al. and Komatsubara et al. is as applied in the Office Action dated March 14, 2003 and incorporated herein. The rejection has been maintained for the following reasons below.

Applicants state that none of the references relied upon by the Examiner purport to reduce the surface magnesium content of an aluminum alloy so that it can be anodized and subsequently colored. In response, Akin teaches the immersing step of

present claims 3-4 and 6-7. Similar processes can reasonably be expected to yield products which inherently have the same properties. *In re Spada* 15 USPQ 2d 1655 (CAFC 1990); *In re DeBlauwe* 222 USPQ 191; *In re Wiegand* 86 USPQ 155 (CCPA 195).

Furthermore, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the Applicants. *In re Linter* 458 F 2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon* 919 F 2d 688, 16 USPQ 2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 USPQ 904 (1991); and MPEP § 2144.

Applicants state that the prior art fails to recognize the problem solved by the rejected claims, there is no direction provided in the prior art for parameters that can be used to solve the unrecognized problem. There is no prior art direction or known practice for producing a clear anodized coating on high magnesium content aluminum alloys so that they can be colored. In response, the problem solved (reason for doing) and the result of a clear anodized layer (outcome) are not method steps and fail to distinguish the method from the prior art.

It is taught by Gillich that anodizing in a sulfuric acid electrolyte is known to produce clear layers (col. 1, line 66 to col. 2, line 10). The sulfuric acid concentration is a result-effective variable and one skilled in the art has the skill to calculate the

concentration that would determine the success of the desired reaction to occur, i.e., to produce a clear anodized layer, absent evidence to the contrary. MPEP § 2141.03 and § 2144.05(b).

The only difference between the present independent claims 1 and 5 and Korte is wherein the aqueous sulfuric acid bath contains 100-200 grams of sulfuric acid per liter of bath. The manipulation of the concentration of sulfuric acid 100-200 grams of sulfuric acid per liter of bath produces no unexpected results since clear anodized layers are known in the art from sulfuric acid electrolytes.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Edna Wong whose telephone number is (703) 308-3818. The examiner can normally be reached on Mon-Fri 7:30 am to 5:00 pm, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (703) 308-3322. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 873-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1495.

Edna Wong
Primary Examiner
Art Unit 1753

EW
June 29, 2003